

**Amendments to the Drawings**

The attached sheet of drawings includes changes to Fig. 7a and Fig. 7b.

Attachment: Replacement sheet

## REMARKS/ARGUMENTS

In response to the objection to Figures 7a and 7b of the drawings, please find enclosed a corrected sheet of drawings. In addition, paragraphs [0015], [0023], [0025] and [0026] are being replaced to correct the description of Figs. 7a and 7b. No new matter is being introduced into the application with these corrections.

In paragraph 3. of the Office Action, claims 8-10 were rejected under 35 U.S.C. 112, second paragraph as being indefinite in the language “two parallel lug” and “protrusion”. This ground of rejection is courteously traversed as it applies to the claims now presented for further examination.

Claims 8 and 13 have been corrected to –two parallel lugs--.

The term “protrusion” in claim 9 appears to be reasonably precise, and therefore, not indefinite as alleged. The term “protrusion” means to jut out or to project. In this regard, page 9, lines 29-30 of the specification state the sidewalls 53 and 54 each have a protrusion 61, wherein slide 4 is not completely in contact against left and right sidewalls 53 and 54. This is because a portion of the sidewall of the transport container 40 protrudes inwardly as a flattened ledge leaving a space between the edge of slide 4 (not shown) and the inner sidewall. This flattened structure 61 “protrudes” inwardly as best illustrated by Fig. 7a, and therefore, the term “protrusion” is believed to be accurate, and in compliance with 35 U.S.C. 112, second paragraph.

The Office Action also concludes that claim 10 is indefinite in light of the expression “dimensionally stable material”. Applicant courteously disagrees. The expression “dimensionally stable” is a widely used expression, especially in the field of material science, and generally denotes a material retaining its size and configuration under the conditions of use. Paragraph [0023] on page 9 discusses “dimensionally stable material” used in fabrication of transport container 40 to include aluminum, and filled or unfilled polymer material, as representative materials.

Hence, the expression “dimensional stable material” is widely recognized and understood. In addition, the expression is also being correctly used in its ordinarily understood meaning, is reasonably precise and accurate, and supported by specific representative examples. Hence, the expression is definite and in compliance with 35 U.S.C. 112, second paragraph.

In summation, because the language of claims 8-10 is reasonably clear and precise, Applicant maintains they are in compliance with 35 U.S.C. 112, second paragraph. Withdrawal of the rejection of claims 8-10 is respectfully requested.

At paragraph #5 of the Office Action, claims 1-2, 9-10 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. This ground of rejection is courteously traversed as it applies to the claims now presented for further examination.

Kato et al fail to teach as to anticipate (35 U.S.C. 102) or to suggest as to render obvious (35 U.S.C. 103) the subject matter of claims 1-2, 9-10 and 14, as alleged. More specifically, Kato et al fail to disclose the combination of both a peripheral delimiting wall with at least one peripheral step formed in the interior wall side in combination with a base comprising elevations adapted for providing additional support to the slide for immunological labeling. Furthermore, there is no suggestion of an elevation on the base structure of Kato et al to provide such additional support.

With regard to claim 10, which is dependent from claim 1, Kato et al would not teach or suggest the subject matter of claim 10 for two reasons. Firstly, Kato et al repeatedly teach the shelf sections are each formed with a size and width sufficient to eliminate the necessity of forming shelf sections with high dimensional accuracy, at col. 3, lines 43-46; col. 7, lines 30-32 and 51-54; and col. 8, lines 42-44. This packaging of Kato et al is fabricated from a pliable carrier strip or tape with sprocket perforations on one side for accurate feed control for use in protective packaging of semi-conductor devices after manufacturing. This is discussed at col. 1, beginning at line 46, and bridging to col.2.

Applicant also wishes to highlight for the examiner's benefit that Kato et al would effectively teach away from the use of base elevations in their packaging according to Applicant's claim 1 because Kato et al are striving to protect semi-conductor electrodes "Sa" from making contact with the bottom surface structures of their receiving recesses. This is best illustrated by Fig. 2 of Kato et al, wherein Sa electrodes are illustrated, and are discussed at col. 7, lines 46-50. That is, Applicant's base elevations in the semi-conductor packaging according to Kato et al would be inappropriate because Kato et al is striving to protect electrodes on the bottom side of his packaging from contacting packaging surfaces, and would avoid such structural feature as recited in Applicant's claim 1 and claims dependent therefrom. Hence, it would be both novel and non-obvious in view of the teachings of Kato et al to introduce supporting elevations in the base according to applicant's amended claim 1.

Claim 14 is also novel and non-obvious over the disclosures of Kato et al. Claim 14 provides that the peripheral step formed on the inside surface of the peripheral delimiting wall is continuous. In this regard, Kato et al teach all embodiments of their device having protrusions 63 or 64 according to Figs. 16a to 17b are discontinuous and do not run the length of the entire length of the peripheral delimiting wall.

In view of the foregoing structural distinctions over the devices of Kato et al, reconsideration and withdrawal of the rejection of claims 1-2, 9-10 and 14 as lacking novelty under 35 U.S.C. 102(b) are courteously requested.

In the Office Action of May 31, 2006, claims 1-4, 9-10 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Nakazono et al. This ground of rejection is courteously traversed as it applies to the claims now presented for further examination.

Nakazono et al fail to teach all the elements of the rejected claims under 35 U.S.C. 102(b), or to suggest as to render obvious under 35 U.S.C. 103(a) the invention as recited in claim 1 or the rejected claims dependent therefrom. In this regard, the base 6 of Nakazono et al do not teach elevations operatively arranged for providing additional

support for a packaged article. According to this reference article 2 is a liquid crystal panel. According to Nakazono et al, tray 1 includes a LC panel holding concave portion 3 for holding LC panel 2. However, it appears from Fig. 1 that panel 2, the packaged article, rests on a bezel 4, but not an elevation from the base

In addition to the foregoing features, independent claim 14 characterizes the base of a transport container as such it simultaneously closes-off the next adjacent transporting container below it by engaging with one of its peripheral steps. This is much more than a mere stacking capability like the trays of Nakazono et al. The base of Applicant's transporting containers interact by engaging with one of the peripheral steps of the next adjacent transporting container below it to provide a sealing effect, whereas the trays of Nakazono et al do not teach the concept of the base of one tray engaging with the interior step of the next adjacent tray as a closure system.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-4, 9-10 and 14 under 35 U.S.C. 102(b) as fully met by Nakazono et al are courteously requested.

At para. 8 of the Office Action, claims 5-6 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al or Nakazono et al in view of Chenoweth and Bloom. This ground of rejection is courteously traversed.

Agreeably, **neither** Kato et al, **nor** Nakazono et al teach or suggest first and second elevations on the base. However, it remains doubtful, at best, it would be obvious within the framework of Section 103 to modify the structures of the primary references by introducing only the elevations of Chenoweth and Bloom, into the structures of Kato et al and Nakazono et al, as concluded by the Office Action. For example, the carrier tape of Kato et al is for packaging semiconductors "Sa" (Fig. 3) wherein the devices are supported by the peripheral edge of shelf sections 21 to avoid contact with the base. This alone would **at least suggest or teach away** from introducing base elevations into the semiconductor packaging of Kato et al.

Nakazono et al employ a bezel frame 4 of metal for holding and protecting the LC panels.  
The rationale for employing elevations like those of Chenoweth and Bloom in the device of Nakazono et al appears doubtful.

Claim 11 is indirectly dependent from claim 1 and includes the base elevations of amended claim 1.

Accordingly, reconsideration and withdrawal of the rejection of claims 5-6 and 11 for reasons of obviousness are courteously requested.

At par. 9 of the Office Action, claims 7 and 12 were rejected under 35 U.S.C. 103(a) as unpatentable over Nakazono et al in view of "The Official Notice". This ground of rejection is courteously traversed.

It is assumed, "The Official Notice" cited by the examiner is intended to mean "**judicial notice**", wherein instead of relying on published prior art, the examiner is urging the "two grip recesses" in the region of the front wall are so well known that there is no need to cite published prior art, but instead merely cite it as a fact.

Applicant courteously disagrees the "two grip recesses" are so well known that prior art need not be cited, especially when used in the environment of a transport for slides for immunological labeling. The subject matter is not so common that the Examiner can dispense with the citation of published prior art. **MPEP Section 2144.03**

Accordingly, claims 7 and 12 should be in condition for allowance. However, in the event the rejection of claims 7 and 12 is maintained it is respectfully requested that published prior art be cited in support of the rejection of the claims.

In Par. 10 of the Office Action, claims 8 and 13 were rejected under 35 U.S.C. 103(a) as unpatentable over Nakazono et al in view of Lafond et al or Burton et al. This ground of rejection is respectfully traversed.

Claim 8 includes all the limitations of claim 1, including base elevations operatively arranged for providing further support for a slide mounted onto the transport container. Hence, the combination of Nakazono et al, Lafond or Burton et al do not render the claim unpatentable for any reason, and therefore, the rejection should be withdrawn.

With respect to claim 13, Applicant disagrees with the conclusion that it would have been obvious in view of Lafond or Burton to modify the container of Nakazono et al in the region of the back wall to include two parallel lugs to facilitate stacking. This is because Nakazono et al already utilizes a system for facilitating stacking that is different than the system employed by Lafond or Burton. This is discussed by Nakazono et al in detail beginning near the bottom of Column 5, beginning with line 58, and bridging over to Col. 6, etc. Essentially, Nakazono et al employ a plurality of concave portions 11 which they refer to as "position determining portions". Applicant refers the Examiner to this portion of the text of the Nakazono et al reference which discusses how the concave portions of one tray interconnect with the corresponding portions in the next lower tray, and so on. It remains unclear to Applicant what motivation there would be to substitute the parallel lugs of Lafond or Burton for the system of Nakazono et al, other than impermissible hindsight from a prior reading of Applicant's own disclosure.

Accordingly reconsideration and withdrawal of the rejection of claims 8 and 13 for reasons of obviousness are courteously requested.

**Applicant wishes to also point for the record that those rejections of the claims under 35 U.S.C. 103(a) appearing in paragraphs 8, 9 and 10 of the Office Action fail to make out a *prima facie* case of obviousness.** Assuming arguendo the combination of references cited in these rejections show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, as to why an artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose a particular element, especially from the secondary references, from the several possible elements these secondary references disclose to the exclusion of other elements, in order to arrive at the claimed invention. In the Office Action of May 31,

2006, in the rejections based on 35 U.S.C. 103(a), the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known.

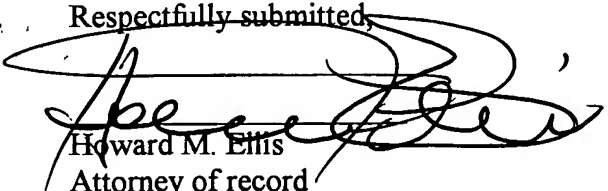
The claimed invention, however, is clearly directed to a combination of elements. Applicant does not claim that he invented one or more new elements, but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

As stated above, the examiner has done little more than cite secondary references that have the element missing from the primary reference, and then conclude it would be obvious to introduce or substitute the element of the secondary reference into the device of the primary reference. This violates numerous court decisions, e.g., *In re Geiger* 2 USPQ2d 1276 (CA Fed Cir. 1987); etc., and Office guidelines set-forth in the MPEP.

Accordingly, in view of the amendments to the drawings, specification and the amended claims, including the foregoing discussion on the failure to make out a *prima facie* case of obviousness, and other remarks distinguishing over the references applied in rejecting the claims, it would appear the rejections have been obviated, so as to place this application in condition for allowance. Notification of the same at an early date is earnestly solicited.

August 31, 2006

Respectfully submitted,



Howard M. Ellis  
Attorney of record  
Reg. No. 25856  
Tel. (716)626-1564